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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,226	08/03/2006	Peter Kruger	KRUGER1	6463
1444 7590 05/23/2008 BROWDY AND NEIMARK, P.L.L.C. 624 NINTH STREET, NW SUITE 300 WASHINGTON, DC 20001-5303				
EXAMINER				
PARVINI, PEGAH				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/588,226

Applicant(s)

KRUGER ET AL.

Examiner

PEGAH PARVINI

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11, 12, 14-19, 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11, 12, 14-19, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submission filed on March 20, 2008 has been entered.

Claim Objections

Claim 11 is objected to because of the following informalities: in the second line of the claim language, it is recited "a metal effect pigment"; however, further down, said claim recites "said metal pigment". There is not sufficient antecedent basis for the claimed "said metal pigment".

Appropriate corrections are required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 recites the limitation "the metallic substrate" in "...with respect to sweat and saliva preventing direct contact between the human body and the metallic substrate...". There is insufficient antecedent basis for this limitation in the claim as a metallic substrate may not necessarily be made up of metal.

Furthermore, claim 11 recites the limitation "the silica particles" in "...consist essentially of SiO₂; and wherein the silica particles generating the coating....". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-12, 14-17, and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application Publication No. 2003/0051634 to Takahashi in view of US Patent No. 5,624,486 to Schmid et al.

Regarding claims 11 and 12, Takahashi teaches pigments used in various fields such as cosmetics which have a flaky substrate, which is preferably a metal pigment, coated with silicon dioxide through sol-gel process wherein the flaky substrate is entirely coated with silicon dioxide ([0008], [0014], [0017], [0024], [0035]).

Takahashi disclose the sol-gel process as the method to form the silicon dioxide layer on the substrate; nevertheless, this is a process limitation in a product claim; thus, the limitations directed to a method for producing the claimed composition are not considered to add patentable weight to the examination of the product claim.

Although Takahashi disclose the application of a further layer of metal oxide onto the said metal substrate coated silicon dioxide, the term "having" in the claim language does not exclude the existence of any other layers on the layer encapsulating the metal substrate since "having" is not a closed terminology.

Takahashi may not expressly disclose the particle size of the silica particles; however, Schmid et al. which also teach coating a platelet-like metallic substrate consisting essentially of aluminum with silicon oxide to form a pigment which is used in various fields such as cosmetics, disclose that thickness of silicon oxide is from 50 to 600 nm (column 1, lines 4-9, 50-60; column 2, lines 42-48; column 3, lines 33-40). Therefore, it would have been obvious that the silicon oxide forming the coating over the substrate can not have a larger particle size than this range which has overlapping ranges with the particle size instantly claimed. Overlapping ranges have been held to establish *prima facie* obviousness. MPEP § 2144.05. With reference to Schmid et al., it is noted that the intermediate product of Schmid et al. is seen to read on the limitations of the instant claim 11 with reference to the structure of a coated substrate.

Furthermore, it would have been obvious to one of ordinary skill in the art to modify Takahashi in order to include any references to the particle size of the silica used to coat the metal substrate as that taught by Schmid et al. motivated by the fact

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that both references are drawn to pigments used in cosmetic preparation. Moreover, Takahashi's pigment has enhanced interference colors and the intermediate product of Schmid et al. is seen to read on the limitations of the coated metal substrate instantly claimed. Again, it is noted that the process limitations in a product claim are not considered to add patentable weight to the examination of the product claim.

With reference to the properties recited in claim 11 such as "providing a barrier effect with respect to sweat and saliva and preventing direct contact between the human body and the metallic substrate", it is noted that the references as combined disclose and suggest a composition which is substantially similar to the one instantly claimed. Thus, such properties are expected to result from the composition disclosed by the combination of references.

Regarding claims 14 and 15, the properties of said claims are expected to result from the composition and structure of the combination of references since said combination disclose a substantially similar structure and composition as that recited in claim 11.

Regarding claims 16 and 21-22, Takahashi teaches the use of between 1 to 100% by weight of metal substrate coated silicon dioxide pigments in a cosmetic formulation depending on the type of cosmetic formulation ([0086]). It is noted that there is overlapping ranges of the amount of said pigment used in cosmetic formulation

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with the ranges instantly claimed, and overlapping ranges have been held to establish prima facie obviousness. See MPEP § 2144.05.

Regarding claim 17, Takahashi discloses the use of the metal substrate coated with silicon dioxide in the nail enamel ([0085]-[0086]).

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi in view of Schmid et al. as applied to claims 11 and 17 above, and further in view of US Patent No. 4,897,261 to Yamazaki et al. in further view of US Patent No. 4,894,224 to Kuwata et al.

Regarding claim 18, the combination of Takahashi and Schmid et al. discloses metal substrate coated with silicon dioxide used in cosmetics wherein the particle size of silicon dioxide has overlapping ranges with the particle size instantly claimed as detailed above.

The combination of references does not expressly disclose the use of nitrocellulose in the cosmetic formulation; however, Yamazaki et al. disclose a fingernail cosmetic composition having a high safety factor comprising nitrocellulose (column 1, lines 1-21; column 2, lines 62-66; column 3, lines 1-5).

Therefore, it would have been obvious to one of ordinary skill in the art to modify the combination of Takahashi and Schmid et al. in order to include the utilization of

nitrocellulose in their cosmetic formulations such as nail enamel motivated by the fact that Yamazaki et al. disclose the use of nitrocellulose in fingernail cosmetic and specially indicates that their fingernail cosmetic has high safety factor superior to previous art (column 2, lines 42-47). However, this combination is, also, motivated by the fact that it is well settled in the art that nitrocellulose is one of the conventional additive used in cosmetic formulations as that taught by Kuwata et al.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi in view of Schmid et al. as applied to claim 11 above, and further in view of US Patent No. 5,089,250 to Forestier et al.

Regarding claim 19, the combination of Takahashi and Schmid et al. discloses metal substrate coated with silicon dioxide used in cosmetics wherein the particle size of silicon dioxide has overlapping ranges with the particle size instantly claimed. Takahashi, also, discloses the addition of UV absorbent in the cosmetic formulations although not expressly disclosing the use of benzotriazoles ([0091]).

Forestier et al. disclose cosmetic compositions comprising benzotriazole used as a UV filter for the protection of skin and hair.

Thus, it would have been obvious to a person of ordinary skill in the art to have modified the combination of references to expressly disclose the use of benzotriazoles and their derivatives in cosmetics motivated by the fact that Forestier et al. disclose the

use of such compounds as UV filtering agents which have good cosmetics and filtering properties over a wide range of wavelengths (column 1, lines 4-10, 33-37, 52-56, 63-67; column 5, lines 5-8; column 6, lines 41-44).

Response to Amendment

Applicants' amendment to claim 11, filed March 30, 2008, page 3, is acknowledged. However, said amendment does not place the application in condition for allowance.

Response to Arguments

Applicants have argued that the finality of the Office Action of December 20, 2007 should be withdrawn because claim 19 was improperly not examined previously and only received its first rejection in the Office Action of December 20, 2007.

The Examiner, respectfully, submits that claim 19 was made final as necessitated by amendments; in addition, said claim was improper as presented in August 3, 2006, for improper multiple dependency.

Applicants have argued that Schmid et al. and Takahashi are drawn to multiply coated pigments.

The Examiner, respectfully, submits that the intermediate product of Schmid et al. (a platelet-like metallic substrate coated with a layer consisting essentially of silicon oxide) would read on the limitation of instant application. Furthermore, the language of

claim 11 recites "...having a single layer encapsulating the substrate....". It is noted that "having" is not a closed phrase such as "consisting of".

It is noted that Applicants in their arguments indicated that the prior amendment to claim 11 included the closed language of "consisting of"; however, said prior amendment included the transitional phrase "consisting essentially of" which limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. In re Herz, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PEGAH PARVINI whose telephone number is (571)272-2639. The examiner can normally be reached on Monday to Friday 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. P./
Examiner, Art Unit 1793

/Jerry A Lorengo/
Supervisory Patent Examiner, Art
Unit 1793